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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/230,048	03/12/1999	BERNHARD FLECKENSTEIN	058315/0129	4939

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EXAMINER

KAUSHAL, SUMESH

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 07/02/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/230,048

Applicant(s)

FLECKENSTEIN ET AL.

Examiner

S. Kaushal

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13-17, 29-33, 36-53 is/are pending in the application.
- 4a) Of the above claim(s) 13-15 and 17 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 36-45, 47-49, 51-53 is/are allowed.
- 6) ☒ Claim(s) 16, 46 and 50 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: 35 U.S.C. § 119(e)

## **DETAILED ACTION**

### ***Continued Prosecution Application***

The request filed on 04/17/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09230048 is acceptable and a CPA has been established. An action on the CPA follows.

*Claims 1-6, 8-12, 16 18-20, 28 and 34-35 were canceled.*

*Claims 36-53 were newly filed.*

*Claims 36-53 were pending and were examined in this office action.*

► *If the claims are amended, added and/or canceled in response to this office action the applicants are required to follow Amendment Practice under 37 CFR § 1.121 (<http://www.uspto.gov>) and A CLEAN COPY OF ALL PENDING CLAIMS IS REQUESTED.*

### ***Claim Objections***

Claim 40 is objected to because of the following informalities: The instant claim fails to recite the SEQ ID NO for the amino acid sequence as claimed. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 46 and 50 are rejected under 35 U.S.C. 102(e) as being anticipated by Ganem et al (US 5/861, 240, 1999, filed 02/28/1996, *ref of record*).

The instant claims are drawn to an isolated nucleic acid molecules that hybridize to SEQ ID NO:1 wherein the nucleic acid encodes functional v-IL-6. The claims are further drawn to a cell culture growth medium comprising v-IL-6 activity.

Ganem teaches isolated human herpesvirus type 8 sequences (fig-1). The cited art teaches recombinant cells containing isolated HHV-8 DNA molecules that encode HHV-8 recombinant proteins (col.2 line 32-55, col.5, line 56-68, col.8, line 7-10). The cited art further teaches recombinant or naturally occurring cells that express HHV-8 gene products (col.3, line 5-12). The cited art further teaches the detection of HHV-8 polypeptides in a biological sample using immunochemical assays (col.5, line 3-16, line 31-38). The cited art further teaches the identification of expressed viral genes in infected and uninfected cells (col. 8. line 64-67). The cited art teaches a cell line (BCBL-1, ATCC CRL 11982) encoding HHV-8 genomic DNA that is capable of producing HHV-8 viral particles (col.9, line 35-46). The cited art further teaches a culture of BCBL-1 cells (col.10, line 27-53). The cited art further teaches the treatment of BCBL-1 cells with phorbol ester TPA induces transcription of extensive regions of viral genome and the accumulation of enveloped virions in the cells and medium (col.11, line 12-25). If the composition is physically the same it must have the same properties. In instant case the cited art clearly anticipate the invention as claimed because the composition and functions as claimed are presumed inherent in this context. "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are

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inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) see MPEP § 2112.02.

### ***Conclusion***

Claims 36-45 and 47-49 and 51-53 are allowed

Claims 46 and 50 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumesh Kaushal Ph.D. whose telephone number is (703) 305-6838. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Irem.Yucel can be reached on (703) 305-1998. The fax-phone number for the organization where this application or proceeding is assigned as (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent analyst Zeta Adams, whose telephone number is (703) 305-3291.

*S. Kaushal*

Patent examiner

*Scott D. Pribe*

SCOTT D. PRIEBE, PH.D  
PRIMARY EXAMINER